

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended, and in light of the foregoing comments is respectfully requested.

Claims 1, 2, 4-13, 20-27, 31, 47, 48, 52-61, 66-76, and 81-88 are pending in this application; Claims 1, 7-13, 47, 60 and 75 having been amended by way of this present amendment. Support for the amended claims can be found in the original specification, claims, and drawings.¹ Thus, no new matter is presented.

Claims 1, 2, 4-13, 20-23, 25, 26, 31, 47, 52, 54-61, 67, 69, 70-74, 75-77, 80, 81, and 83-88 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldstein (U.S. patent 5,410,326, hereinafter Goldstein) in view of Niimi et al. (U.S. patent 5,996,028, hereinafter "Niimi"). Claims 24, 27, and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldstein in view of Niimi and in further view of Hirose (U.S. patent 5,917,915).

The Applicants appreciatively acknowledge the courtesy extended by Examiner Sajous by holding a personal interview with the undersigned on July 27, 2004. The substance of the interview is reflected in amended Claims 1, 7-13, 47, 60 and 75, as discussed below.

In the interview an overview of the claimed invention was provided to Examiner Sajous and distinctions between the applied prior art (Goldstein in particular) were discussed. Examiner Sajous also indicated that amending the independent Claims to further describe the function of the detachable IC memory card would place the claims in better condition to overcome the prior art of record. In response 1, 7-13, 47, 60 and 75 have been amended to recite that "said detachable IC memory card is configured to be removable and utilized in an external process."

¹ Specification at page 34, lines 8-10.

Briefly recapitulating, the present claims relate to a control device and associated method of initiating an interactive operation between a remote control unit and an electronic apparatus.² The remote control unit receives information from the electronic apparatus it is controlling and based on a user controlled input, the received information can be stored onto a detachable IC memory card 2. In an exemplary embodiment, coupon information can be provided from the electronic apparatus to the remote controller 1 and then selectively stored into the detachable IC memory card 2. With such a structure, a user of the remote control unit can remove the IC card 2 from the remote control unit and redeem the coupon at a retail location.³

Claim 1 recites, *inter alia*, a control device including:

“...an output unit for outputting the additional information received by the receiver to a display device...

a memory for storing, based on a user controlled input, at least a portion of said additional information, the memory including a detachable IC memory card...

said detachable IC memory card is configured to be removable and utilized in an external process.”

Applicants respectfully traverse the rejection of Claim 1 as being obvious over Goldstein. The basic requirements for a *prima facie* case of obviousness are (1) there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference must teach or suggest all the claim limitations. It is respectfully submitted that the outstanding Office Action fails to make a *prima facie* case of obviousness, because even if Goldstein and Niimi were to be combined the combination fails to teach or suggest all the

² Specification at Figure 1.

³ Specification at pages 31-32.

limitations recited in Claim 1. Further, there is no suggestion or motivation to modify Goldstein with Niimi.

The outstanding Office Action recognizes that Goldstein fails to teach a detachable IC memory card and an erasing unit for deleting the information stored in the memory based on the user controlled input. The outstanding Office Action then cites the teachings of Niimi to cure the deficiencies of Goldstein.⁴ Applicants respectfully submit that Goldstein and Niimi, even if combined, fail to anticipate all the elements recited in amended Claim 1.

Amended Claim 1 recites that a detachable IC memory card is configured to be removable and utilized in an external process. In contrast, Niimi describes that the memory card, in his application, stores information regarding the user of the telephone device for which the card is intended to be used. Specifically, Niimi describes that information such as name of the user, a telephone directory database, and the functions regarding the settings of the telephone terminal are stored.⁵ Therefore, the memory card described by Niimi fails to teach or suggest that the detachable IC memory card is configured to be removable and utilized in an external process, as recited in amended Claim 1.

Further, the Official Action dated April 21, 2004 (hereinafter, "the Official Action") states that "it is apparent that the detachable memory and the user terminal are linked together, wherein the user memory or terminal is construed as the electronic apparatus, and upon a user command, an operation to store information from the user memory to the detachable memory is permissible, wherein the key input from the user characterizes the control device."⁶ Thus, the Official Action interprets the detachable memory 20 of Niimi, as the electronic apparatus as recited in Claim 1, and the terminal as the control device, as recited in Claim 1. However, Claim 1 also recites that the control unit receives additional

⁴ Office Action of April 21, 2004, page 5, lines 20-27.

⁵ Niimi at column 6, lines 60-63.

⁶ Office Action of April 21, 2004, at page 4.

information that has been extracted and transmitted from the electronic apparatus, and that a memory stores a portion of this additional information (received by the control unit), the memory including a detachable IC card. Amended claim 1 further recites that said detachable IC memory card is configured to be removable and utilized in an external process.

Therefore, as recited in amended Claim 1, the detachable memory must store information that is received by the control unit. According to the interpretation of Niimi asserted in the Official Action, the configuration recited in amended Claim 1 would be inoperable for its intended purpose, because the detachable memory would be serving the function of transmitting information received from a transmission medium to the control unit. Given this interpretation, the detachable memory in Niimi could not function as the memory unit attached to the control unit, because it would be configured to receive information from a transmission medium and transmit the information to the control unit. Thus, it would not be possible for the detachable memory card in Niimi to perform the operation of the electronic apparatus, as recited in amended Claim 1.

Thus, Niimi also does not teach or suggest any operations in which information stored in the detachable memory 20 is information received from an electronic apparatus being controlled by a control device. Niimi merely discloses being able to utilize different telephone directory databases in different detachable memories 20 to be placed in a telephone. Such teachings do not appear to have relevance to the claims in which the information stored in the memory is information received from an electronic apparatus being controlled by the control device, such as a remote controller.

Another basis for the outstanding rejection relies on Goldstein disclosing a memory, for example elements, and storing information therein directed to favorite channel information.⁷

More specifically, as recited in amended Claim 1, information stored in the detachable IC memory card of the control unit is information received from the electronic apparatus. That is not the case with respect to the favorite channel information of Goldstein. The Advisory Action of July 16, 2004 (hereafter, "the Advisory Action") states that Goldstein teaches that identity of selected channels constitutes the basis for a favorite channel database contained in the RAM memory. The Advisory action further asserts that that this implies that a memory exists for storing at least a portion of said additional information, based on a user controlled input.⁸ However, Goldstein simply discloses an operation for recording favorite channel information "by monitoring keypad selections 470 of the touch-sensitive screen 10 in a particular mode of interest".⁹ The identity of the channel being the keypad selections made by the user which are stored in RAM, based on the keypad selections of the user. Thus, in Goldstein, the favorite channel information is not additional information received from an electronic apparatus that the controller is controlling as recited in amended Claim 1, but instead is only based on monitoring keypad selections of the remote controller itself.

Further, the Office Action states that "it is clear that the control device is well capable of controlling and receiving information from an electronic device."¹⁰ This assertion in the Official Action appears to be based on Goldstein's remote control device communicating bi-directionally with a television receiver that receives programming information from a head end cable of a remote data source, and the cable system and head end downloads information

⁷Office Action of April 21, 2004, page 5, paragraph 2.

⁸ Advisory Action at page 3, lines 1-10.

⁹ Goldstein at column 26, lines 27-29.

¹⁰ Office Action of April 21, 2004, page 2, paragraph 3.

to the remote control device.¹¹ However, as stated in the Official Action, Goldstein describes that the information downloaded from the television receiver and head-end device is controlled and received, but not stored based on a user's input.¹² Goldstein suggests that the remote control device can be used to store a user's favorite channel selections, based on a user's previous selections, and command the television receiver to tune and display subsequent broadcasts.¹³ However, the information stored regarding the favorite channel information consists of only keypad selections, not additional information provided from the electronic apparatus under control.¹⁴

Moreover, Goldstein fails to teach or suggest that any of the information transmitted from the head-end device, or television receiver, is stored based on these user selections. Goldstein only stores channel selections of the user of the remote control device and is able to control and receive information from a remote source, but at no point does Goldstein teach or suggest storing at least a portion of said additional information (received by the controller), based on a user controlled input.

Additionally, the teachings in Niimi are not properly applicable to the teachings in Goldstein as Niimi is directed to a telephone type device that can include a detachable memory 20. Niimi discloses utilizing a detachable memory 20 for storing a telephone directory database.¹⁵ Such teachings in Niimi are completely unrelated to the teachings in Goldstein. That is, the teaching of storing a telephone database in a telephone device in Niimi has no relevance in relation whatsoever to a universal remote control device for a device such as a cable converter television as in Goldstein.

¹¹ Goldstein at column 3, lines 17-44.

¹² Office Action of April 21, 2004, at page 4.

¹³ Goldstein at column 26, lines 15-40.

¹⁴ Goldstein at column 26, line 28.

¹⁵ Niimi at column 4, lines 53-59.

For example, in Niimi the user of a telephone device may remove the detachable memory, which includes their personal phone book, and use the memory device in another phone capable of reading the memory device. In contrast, this activity would not be advantageous with Goldstein's remote device, as cable services and channel arrangement vary with each household's particular plan or service provider. Alternatively, telephone numbers, as applied in Niimi's device are relatively universal and have the same constitution regardless of the phone from which the number is dialed. Clearly, one of ordinary skill in the art would not see any relevance in utilizing a detachable memory that can store telephone database information to a device such as in Goldstein.

Further, Goldstein's disclosure fails to provide any motivation, whatsoever, to add a detachable memory card, such as that disclosed by Niimi. The primary information stored in memory in Goldstein's device is the sequence and frequency of keypad depressions made by the user of the remote control device. There is no motivation to add to Goldstein a removable memory card to which the favorite channel information can be stored, because it would add no additional functionality or provide any additional benefit to Goldstein's device. As stated above, adding a detachable memory device to Goldstein so that the favorite channels of a user can be transported to one remote control to another fails to be beneficial because cable services and channel configurations vary from household to household. In fact, Goldstein specifically teaches away from this feature, by stating that selections are made by a user based on the services for which a contract has been obtained by a specified user.¹⁶

Accordingly, Applicant requests that the rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn. Amended Claims 7-13, 47, 60, and 75 recite substantially the same limitations discussed above with regard to Claim 1 and therefore also patentably define over Goldstein and Niimi.

¹⁶ Goldstein at column 3, lines 45-51.


As discussed above, Goldstein, neither alone nor in combination with Niimi, disclose or suggest the Applicants' invention as recited in Claim 1. Likewise, Hirose does not remedy the deficiencies noted above, and therefore, none of the cited references, neither alone nor in combination, can be properly asserted as disclosing or suggesting Applicants' remaining dependent Claims 2, 4-6, 20-27, 31, 33-46, 48, 52-, 59, 61, 65-74, 76, and 81-88, which included the above distinguished limitations by virtue of their independent recitation or dependency. Therefore, the Official Action does not provide a *prima facie* case of obviousness with regard to any of these claims.

Accordingly, Applicants respectfully requests the rejection of Claims 1, 2, 4-14, 20-27, 31, 33-48, 52-61, 65-76, and 81-88 under 35 U.S.C. §103 be withdrawn.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1, 2, 4-14, 20-27, 31, 33-48, 52-61, 65-76, and 81-88 is patentably distinguishing over the prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/03)
GJM:SNS:asa

I:\ATTY\ATH\PROSECUTION\20's\205602-US\205602US-AM4.DOC

Scott A. McKeown
Registration No. 42,866